

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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| In re Application of | : | Customer Number: 46320 |
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| Michael AU, et al. | : | Confirmation Number: 3098 |
| | : | |
| Application No.: 10/751,742 | : | Group Art Unit: 3625 |
| | : | |
| Filed: January 5, 2004 | : | Examiner: J. Dunham |
| | : | |
| For: SUPPLIER HUB WITH HOSTED SUPPLIER STORES | : | |

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated October 1, 2008.

The Examiner's response to Appellants' arguments submitted in the Appeal Brief of February 6, 2008, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Appeal Brief of February 6, 2008, and the arguments set forth below.

REMARKS

Non-Compliant Examiner's Answer

On page 5 of the Appeal Brief, Appellants pointed out where the Examiner's Answer is required to include particular content discussed in M.P.E.P. § 1207.02, yet the Examiner has completely ignored this requirement. As noted throughout the prosecution of this application and in the Appeal Brief, the Examiner has failed to properly establish the facts underlying the Examiner's analysis. Appellants' position is that these omissions in the Examiner's prima facie analysis are correctable by the Examiner, and the correction of these omissions would help both Appellants and the Honorable Board gain a better understanding of the findings of facts and analysis employed by the Examiner in rejecting the claims. Thus, Appellants respectfully recommend that the Honorable Board remand the present application to the Examiner to address these omissions.¹

Rejection of Claim 1 under 35 U.S.C. § 102

On pages 6-10 of the Appeal Brief, Appellants presented arguments, generally applicable to all of the Examiner's rejection, as to the Examiner's failure to properly establish a prima facie case of anticipation. Specifically, the Examiner neither identifies the specific teachings being relied upon nor provide claim construction for terms at issue. Instead, the Examiner's analysis

¹ The Board has persistently declined to uphold an Examiner because of omissions in the Examiner's half of the record. *E.g.*, Ex parte Dalciden, Appeal 2007-1003 (Mar. 14, 2007) (remanding because examiner failed to respond to arguments in the Appeal Brief); Ex parte Rozzi, 63 USPQ2d 1196, 1200-03 (BPAI 2002) (remanding without decision because of a host of examiner omissions and procedural errors); Ex parte Gambogi, 62 USPQ2d 1209, 1212 (BPAI 2001) ("We decline to tell an examiner precisely how to set out a rejection."); Ex parte Jones, 62 USPQ2d 1206, 1208 (BPAI 2001) (refusing to adjudicate an issue that the examiner has not developed); Ex parte Schricker, 56 USPQ2d 1723, 1725 (BPAI 2000) ("The examiner has left applicant and the board to guess as to the basis of the rejection ... We are not good at guessing; hence, we decline to guess."); Ex parte Bracken, 54 USPQ2d 1110, 1112-13 (BPAI 1999) (noting that the appeal is "not ripe" because of omissions and defects in the examiner's analysis).

relies upon generalizations and ambiguity in attempt to disguise the fact that the applied prior art fails to teach many of the limitations for which the Examiner is relying upon the prior art to teach. On pages 10-15 of the Appeal Brief, Appellants presented several sets of arguments with regard to claim 1.

The Examiner's response to these arguments are found on pages 7-10 of the Examiner's Answer. However, instead of clarifying the Examiner's analysis by more clearly identifying the teachings within Haynes being relied upon, over half of the Examiner's analysis is spent explaining, in the abstract, why the Examiner believes that the Examiner's analysis was proper. Thus, much of the Examiner's response does little to clarify any of the issues raised by Appellants in the Appeal Brief and during prosecution of the present application.

The Examiner's first substantive response is found on page 8 of the Examiner's Answer. The first portion of the Examiner's response is already reproduced on page 10, line 9 through page 11, line 7 of the Appeal Brief. Thus, the only apparently new analysis is found in the last full paragraph on page 8 of the Examiner's Answer and is reproduced below:

Reference is also made to paragraph 22 of Haynes disclosing storing specific catalogs for each supplier of plurality of suppliers on a database structure (see also figure 1). The cited passages of the prior art in the rejection not intended to be limiting, the reference as a whole must be considered.

Notably absent from this paragraph is any explanation as to why the Examiner believes paragraph [0018] teaches the claimed (i) a plurality of supplier catalogs; (ii) receiving the plurality of supplier catalogs; (iii) a plurality of suppliers; (iv) aggregating the plurality of supplier catalogs; and (v) an aggregated catalog (see page 10, lines 23-25 of the Appeal Brief).

For ease of reference, the portion of paragraph [0018] relied upon by the Examiner is reproduced below:

In another aspect of this invention, there is described a method of constructing a searchable database that stores at least one catalogue of items that may be bought by at least one buyer and are supplied by at least one supplier.

This paragraph makes no explicit mention of aggregating a plurality of supplier catalogs. In fact, the notion of aggregation of catalogs is entirely absent from this passage. Moreover, the Examiner has failed to establish this limitations is inherently disclosed. Also absent from paragraph [0018] is a discussion of receiving a plurality of supplier catalogs.

Referring to the paragraph spanning pages 8 and 9 and the first full paragraph on page 9 of the Examiner's Answer, the Examiner refers to the standard for claim construction. However, the Examiner fails to set forth a claim construction for any of the terms at issue.

As to the Examiner's reference to 37 C.F.R. § 1.111(b), Appellants can only point out the error in the Examiner's analysis when the Examiner actually sets forth an explicit analysis. For example, by failing to specifically identify a teaching corresponding to the claimed "plurality of supplier catalogs," Appellants cannot argue, with any specificity, why the Examiner has erred. Instead, Appellants can only argue that the teachings relied upon by the Examiner fail to teach this limitation. As another example, if the Examiner does not provide a claim construction, e.g., for the phrase "plurality of supplier catalogs," Appellants cannot point out how the Examiner has erred in construing this term. By ambiguously referring to both the claim limitations and the teachings of the applied prior art, the Examiner has limited the type of arguments that Appellants can present.

In the paragraph spanning pages 9 and 10 of the Examiner's Answer, the Examiner set forth the following response:

Appellant argues in the last paragraph of page 13 of the brief that a catalog is defined as "a list of items that are accessible by a user, as a list". No such definition is present in appellant's specification. Haynes defines a searchable database as a catalog accessible by users consisting of supplier items (see at least paragraph 18). The examiner submits that by not defining catalog in appellant's specification, a determination of the broadest reasonable meaning of the term was made and the searchable database of Haynes discloses the catalog of claim 1. Once again, the appellant is confusing the issue at hand by not addressing the fact that Haynes discloses each supplier supplying their own catalog and a buyer being entitled to search the entire database.

At the outset, Appellants note that the Examiner criticizes Appellants' proposed claim construction for the term catalog (see page 13, line 14 through page 14, line 23). However, Appellants' claim construction was supported by a dictionary definition, which is reflective of the ordinary and customary meaning attributed to the term by one skilled in the art. As noted by the Federal Circuit in Ferguson Beauregard/Logic Controls et al. v. Mega Systems, LLC et al.:²

We begin our claim construction analysis with the words of the claim. [cite omitted] "In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to 'particularly point [] out and distinctly claim [] the subject matter which the patentee regards as his invention.' 35 U.S.C. § 112, ¶ 2." [cite omitted] In the absence of an express intent to impart a novel meaning to the claim terms, the words take on the full breadth of the ordinary and customary meanings attributed to them by those of ordinary skill in the art. [cite omitted] The ordinary and customary meaning of a claim term may be determined by reviewing a variety of sources. Some of these sources include the claims themselves, [cite omitted]; dictionaries and treatises, [cite omitted]; and the written description, the drawings, and the prosecution history [cite omitted].

On the contrary, the Examiner **mischaracterizes** the teachings of Hayes by asserting that "Haynes defines a searchable database as a catalog accessible by users consisting of supplier items." Haynes does not define a searchable database as a catalog. Instead, Haynes teaches a "searchable database that stores at least one catalogue of items." Based upon this teaching,

² 350 F.3d, 1327, 69 USPQ2d 1001 (Fed. Cir. 2003).

Haynes recognizes that the searchable database is separate and distinct from the "at least one catalog of items."

Referring to the last passage of this statement (i.e., "not addressing the fact that Haynes discloses each supplier supplying their own catalog"). The fact that Hayes teaches a supplier has its own catalog is not dispositive as to all of the claimed limitations. The following overview of Haynes is found in paragraph [0047]:

In particular, the E-Commerce system is programmed to establish an interface between at least one buyer and at least one supplier of the products and/or the services, whereby a bi-directional transmission of data is established between the one buyer and the one supplier. Such an interface permits a buyer to search a catalogue of products and/or services of a particular supplier, select particular products and/or services for purchase, facilitate the purchase of the particular products or services, provide financial information to facilitate the buyers providing the supplier with financial information and effect payment to the supplier, authorize the purchase of the selected products and/or services, and provide an indication of the status of the current transaction. (emphasis added)

As described by Haynes, the buyer is not provided with access to an aggregated catalog, as claimed, which is an aggregation of a plurality of supplier catalogs. Instead, Haynes teaches that a buyer is able to search a catalogue of a particular supplier (i.e., a single supplier).

The Examiner's last substantive response as to claim 1 is found on pages 10 and 11 of the Examiner's Answer and is reproduced below

The examiner submits that the recited limitation of a catalog in claim 1 cannot distinguish from the catalog of Haynes as Appellant has not provided a clear definition for a catalog and therefore one of ordinary skill in the art would reasonably define it as a searchable database of items (see at least the abstract of Haynes). Lastly, Appellant refers to a "single catalog of times (sic) stored in the database" on page 15 of the brief as evidence that paragraph 18 of Haynes does not refer to a plurality of catalogs. The examiner disagrees as Haynes is setting forth an example of how the method works for one supplier while the embodiments clearly indicate the method is applicable to multiple suppliers (figure 1 disclosing vendor users). (emphasis in original).

The Examiner continues to mistake the concept of aggregating a plurality of supplier catalogs (as claimed) with being able to search a plurality of supplier catalogs. The step of aggregating is a

step that *transforms* the entities (i.e., supplier catalogs) into a single aggregated catalog via the technique of aggregation. The Examiner, however, has failed to establish that Haynes identically discloses this transformation of the supplier catalogs into an aggregated catalog.

The Examiner's assertion that "Haynes is setting forth an example of how the method works for one supplier while the embodiments clearly indicate the method is applicable to multiple suppliers" ignores that the claimed invention is not simply to a method that employs catalogs from multiple suppliers. Instead, claim 1 is directed to a specific methodology using multiple supplier catalogs that is not identically disclosed by Haynes. Appellants' position is that the Examiner is attempting to distill the invention down to a single concept, and in so doing, the Examiner has lost track of the specific limitations beings claimed.

On page 15, lines 5-12 of the Appeal Brief, Appellants presented additional arguments with regard to claim 1. However, the Examiner did not respond to these arguments in the Examiner's Answer.

Rejection of Claim 2 under 35 U.S.C. § 102

In response to the arguments presented on page 15, line 16 through page 16, line 3 of the Appeal Brief, the Examiner's only response in the Examiner's Answer was to assert "[t]he same rationale is applied to Appellant's arguments regarding claim 2" on page 11 of the Examiner's Answer. However, the Examiner's arguments do not mention the limitations recited in claim 2 (e.g., a supplier hub catalog topology and the aggregation of the aggregated catalog is based upon the supplier hub catalog topology). As such, the Examiner's response is non-responsive.

Rejection of Claim 3 under 35 U.S.C. § 102

In response to the arguments presented on page 16, line 7 through page 17, line 18 of the Appeal Brief, the Examiner asserted the following in the first full paragraph on page 11 of the Examiner's Answer:

The examiner further disagrees with appellant's contention that Haynes does not teach a buyer accessing said aggregated catalog hosted supplier stores owned by said suppliers. Figure 1 and paragraph 48 of Haynes disclose vendor and supplier sites. Appellant's specification does not specifically define "stores" and "owned" and as such the terms are given their broadest reasonable meanings. It is well known within the art that supplier "stores" are web sites and since the sites (22b) are defined as "vendor sites" ownership is indicated. Appellant concedes that the vendor site 22b could be owned by one of the suppliers and the Examiner submits that perhaps the confusion in Appellant's argument is due because Appellant is mistakenly referencing paragraph 47 (as reproduced in the brief) as paragraph 48.

The Examiner's assertion that a site being described as a "vendor site" indicates "ownership" is a factually unsupported inherency argument. A vendor site could be owned and operated by a third party, as is very well known in the art.

As to the Examiner's assertion that Appellants have mistakenly referenced paragraph [0047] in the Appeal Brief as paragraph [0048], this assertion is incorrect. Paragraph [0047] begins "Referring now to the drawings," whereas paragraph [0048] begins "As shown in FIG. 1." Thus, the Examiner is mistaken.

On page 17, lines 14-18 of the Appeal Brief, Appellants presented additional arguments with regard to claim 3. However, the Examiner did not respond to these arguments in the Examiner's Answer.

Rejection of Claim 6 under 35 U.S.C. § 102

In response to the arguments presented on page 17, line 22 through page 18, line 2 of the Appeal Brief, the Examiner asserted the following in the second full paragraph on page 11 of the Examiner's Answer:

Regarding Appellant's argument to claim 6 and "made-to-order" on pages 17-18 of the brief, please note paragraph 58 of Haynes disclosing a buyer making request for proposal for custom (i.e. made-to-order) products.

Although the Examiner asserts that paragraph [0058] of Haynes teaches "a buyer making request for proposal for custom (i.e., made-to-order) products," Appellants review of paragraph [0058] fails to yield any teaching of made-to-order or custom products. This cited paragraph refers to a buyer initiating "a search for a particular product or service." However, this is not comparable to the claimed "quotations for made-to-order items."

For the reasons set forth in the Appeal Brief of February 6, 2008, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 102, 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: November 30, 2008

Respectfully submitted,

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CUSTOMER NUMBER 46320